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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,032	04/08/2004	Daniel J. Miller	MS1-640USC1	2257
22801	7590	02/08/2007		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER HUYNH, BA	
			ART UNIT	PAPER NUMBER
			2179	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/08/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/08/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

**Office Action Summary**

Application No.

10/822,032

Applicant(s)

MILLER ET AL.

Examiner

Ba Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,768,499. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broaden scopes of the pending claims are read on by the patented claims 1-32.
2. Claims 1-39 may be further subjected to a provisional double patenting rejection on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of the copending applications. Due to a large number of co-pending application filed, this provisional rejection will be resolved at the time of allowance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 3,4,6,7,9,10,12,13,15,16,18,19,20,21,24,25,27,28,30,31,33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The phrases “computer-readable media” and “computer-readable medium” are not limited from non-statutory subject matter such as transmission waves.

4. Claims 37-39 are further are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a data structure. Data structure is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 37,39 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5194952 (Pelley).

- As for claims 37, 39: Pelley teaches a computer implemented system comprising a data structure embodied on a computer readable medium, the data structure comprising: one or more portions associated with at least one track of a multi-media editing project, individual tracks being associated with one or more data stream sources; and one or more portions associated with a composite, the composite comprising at least one track (3:60-4:11, 5:31-65, 6:60-68, 16:15-30, 24:44-25:17), said data structure being configured for use in programming a software-implemented matrix switch which is configured to provide a data stream defined by the multi-media editing project (3:52-59, 10:66-11:5).

***Claim rejection under 35 U.S.C. 103***

6. Claims 1-21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US patent application publication 2002/0023103 (Gagne), in view of US patent #5,194,952 (Pelley).

- As for claims 1, 20-21: Gagne teaches a multi-media processing method and corresponding apparatus comprising: providing multiple tracks each of which being capable of being associated with one or more digital data streams (0059, 0062); and representing the multiple tracks as a single track, i.e., the meta clip (0065-0073, figs 5-11). Gagne fails to clearly teach the implementation of the programmable software-implemented matrix switch for processing the digital data associated with the single track. However in the same field of invention, Pelley teaches the implementation of the programmable software implemented matrix switch 18 (21:53-22:24) in which multiple

inputs can be routed to multiple output (21:39-52, fig 3). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Pelley's teaching of the programmable software implemented matrix switch to Gagne for processing the digital data associated with the single track (meta clip). Motivation of the combining is for the advantage of having the switch signal being dynamically re-assignable thus increasing performance and processing time.

- As for claims 2, 3, 4: The act of representing comprises representing at least one transition between at least two of the multiple tracks (0070).
- As for claims 5-7: The act of representing comprises representing at least one effect applied to at least one of the multiple tracks (0070).
- As for claims 8-10: The act of representing comprises representing at least one transition between at least two of the multiple tracks and at least one effect applied to at least one of the multiple tracks (0070, 0071).
- As for claims 11-13: The method further comprising operating upon said single track by applying at least one transition between at least two of the multiple tracks (0070).
- As for claims 14-16: The method further comprising operating upon said single track by applying at least one effect to at least one of the multiple tracks (0070, 0071).
- As for claims 17-19: The method further comprising operating upon said single track by applying at least one transition between at least two of the multiple tracks, and at least one effect to at least one of the multiple tracks (0070, 0071).

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7. Claims 22-36 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US patent application publication 2002/0023103 (Gagne), in view of US patent #6,266,053 (French), further in view of US patent #5,194,952 (Pelley).

- As for claims 22, 35, 36: Gagne teaches a multi-media processing method and corresponding apparatus comprising: providing multiple tracks each of which being capable of being associated with one or more digital data streams (0059, 0062); and representing the multiple tracks as a group upon which operations can be performed that do not affect tracks that are not in the group (0065-0073, figs 5-11). A media project is a hierarchical structure of which the tracks comprise a part (a media project is a time-based hierarchy of media objects). Gagne fails to clearly teach that the hierarchy is a tree structure. However in the same field of invention, French teaches representing a media project as a tree structure. It would have been obvious to one of skill in the art, at the time the invention was made, to combine French's teaching of hierarchical tree structure representation of media object to Gagne. Motivation of the combining is for the advantage of having the ability to integrate a time context and time inheritance into a graph oriented media project, as expressly suggested by French in 6:15-24. The combine Gagne&French fails to clearly teach the implementation of the programmable software-implemented matrix switch for processing the digital data associated with the single track. However in the same field of invention, Pelley teaches the implementation of the programmable software implemented matrix switch 18 (21:53-22:24) in which multiple inputs can be routed to multiple output (21:39-52, fig 3). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Pelley's teaching of

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the programmable software implemented matrix switch to Gagne for processing the digital data associated with the single track (meta clip). Motivation of the combining is for the advantage of having the switch signal being dynamically re-assignable thus increasing performance and processing time.

- As for claims 23-25. The method further comprising operating on said tracks using said particular set of operations (0070, 0071).

- As for claims 26-28. The method of claim 22 further comprising operating on said tracks using said particular set of operations, wherein said particular set of operations comprise at least an effect (0070, 0071).

- As for claims 29-31: The method further comprising operating on said tracks using said particular set of operations, wherein said particular set of operations comprise at least a transition (0070, 0071).

- As for claims 32-34. The method further comprising operating on said tracks using said particular set of operations, wherein said particular set of operations comprise at least an effect and a transition (0070, 0071).

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelley in view of Gagne.

- As for claim 38. Pelley is silent regarding a composite that is nested inside of another composite. However implementation of nested composite is disclosed by Gagne (figure 8). It would have been obvious to one of skill in the art, at the time the



invention was made to combine Gagne's teaching of nested composite to Pelley.

Motivation of the combining is for providing nested editing operation.

### ***Response to Arguments***

Telephone interview: A telephone call was made by the examiner on 2/2/07 in response to a request for interview by Mr. Lance R. Sadler, however Mr. Sadler is no longer with the firm.

Non-Statutory Double Patenting: The applicant request for the Double patenting rejection to be held in abeyance until the time of allowance is noted.

The 35 USC 101 rejection: In response to the argument that the phrases "computer readable medium" and "computer readable media" are defined in the specification as being tangible statutory subject matter. A review of the spec shows that the "tangible statutory subject matter" the applicant referring to on page 10 through page 15 of the specification are merely various implemented examples ("may be", "such as") of the "computer readable medium" and "computer readable media", thus not being excluded from non-statutory subject matter such as transmission waves. *The applicant may consider to amend the claims to include the phrase such as "computer readable storage medium" to overcome the rejection.*

As for claim 37-39: In response to the argument that data structure is statutory subject matter, a data structure per se is merely a collection of items not tangibly embodied to have the capability of providing a tangible useful result, thus is non-statutory. See Warmerdam, 33 F 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held non-statutory).

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As for the 102(b) rejection of claims 37-39: In response to the argument that Pelley does not specifically teach a data structure, a video project represented by the timeline (figs 5-11) is a data structure of time-based media objects.

As for the rejection of claims 1-36: Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ba Huynh  
Primary Examiner  
AU 2179  
2/3/07

**BA HUYNH**  
**PRIMARY EXAMINER**